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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,015	10/28/2003	Thomas Foo	PI1330USNA	4259
43693 7590 01/11/2007 INVISTA NORTH AMERICA S.A.R.L. THREE LITTLE FALLS CENTRE/1052 2801 CENTERVILLE ROAD WILMINGTON, DE 19808			EXAMINER SACKEY, EBENEZER O	
			ART UNIT 1624	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/11/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/695,015

**Applicant(s)**

FOO ET AL.

**Examiner**

EBENEZER SACKY

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is in response to applicant's amendment filed on 10/27/06.

#### **Status of the Claims**

Claim 1 and new claims 2-13 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/06 has been entered.

#### **Claim Rejections - 35 U.S.C. § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claim 1 and new claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breikss (U.S. Patent number 5,523,453)('453') in view of Kreutzer et al., (U.S. Patent number 5,512,696)('696'), which teaches a similar hydrocyanation catalyst as claimed in claim 11 in column 2, lines 20-34, column 11, Comparative example 4 and column 29, lines 40-54 for the reasons set forth in the previous office action mailed on 05/31/06.

### ***Response to Amendment/Remarks***

Applicant's arguments filed 10/27/06 have been fully considered but they are not deemed persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA

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1971). Contrary to applicant's assertion, the Examiner is not making a hindsight rejection because it is well settled that consideration of a reference is not limited to the preferred embodiments or working examples but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art to a person of ordinary skill in the art. See page 3 of the previous office action mailed on 05/31/06, column 1 lines 60 bridging column 2, lines 1-55 and column 12, lines 26-29.

Applicants next argue that the byproduct promoter of the current application contains iron (II) chloride and manganese (II) chloride as well as other metal chlorides and additional components such as sand or coke which would not be obvious to one of ordinary skill in the hydrocyanation art. In response, the claims are simply drawn to hydrocyanation with iron (II) chloride and manganese (II) chloride byproducts. There is no mention of the other chlorides and additional components such as coke and sand in the claims. Therefore, the use of that argument is not germane to the present process barring the inclusion of those components in the claim. Moreover, applicant's specification page 11, lines 4-15 states clearly that byproducts are filtered see below:

[0040] A typical byproduct promoter contains iron (II) chloride and smaller amounts of manganese (II) chloride and other by-product metal chlorides to a much smaller extent, in addition to other materials such as sand or coke. Some of the components of this byproduct promoter are not soluble in solvents for the hydrocyanation process in mixtures of the substrate the nitrites. The byproduct promoter can be added to the hydrocyanation reaction mixture either directly as a solid; or as a slurry in either a hydrocyanation solvent or a mixture of nitrites; or as a homogeneous solution after filtration from materials which are not dissolved in the mixture of substrate nitrites or solvent. Typical methods of filtration applicable to the present invention are taught in Perry's Chemical Engineers' Handbook, McGraw-Hill Publishing Company.

This disclosure connotes that the additional components are indeed filtered out leaving the iron (II) and manganese chlorides prior to the iron and manganese chlorides being used. Thus, arguments to the presence of

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other chlorides and additional components such as coke and sand in the claims is not valid. Moreover, applicants have not shown that the additional components present with iron and manganese chlorides enhance the process by providing better yield and/or selectivity. Applicants next point out that Breikss teaches the use of discrete Lewis acid compounds. The use of a discrete amount of Lewis acid is not precluded from the applicant's considering the use of a broad opened ended language in current claim 1.

Thus, for the reasons of record, claim 1 and new claims 2-13 remain rejected absent a showing of unexpected results and/or results. Regarding unexpected results, such results must be established by factual evidence; mere argument or conclusory statements in the specification do not suffice. Note *Geisler*, 116 F.3d at 1470, 43 USPQ 2d at 1365 (quoting *In re De Blauwe*, 736 F. 2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984)). Furthermore, unexpected results must be established by comparing the claimed invention against the closest prior art. *De Blauwe*, supra; ("[A]n applicant relying on comparative tests to rebut a prima facie case of obviousness must compare his claimed invention to the closest prior art.").

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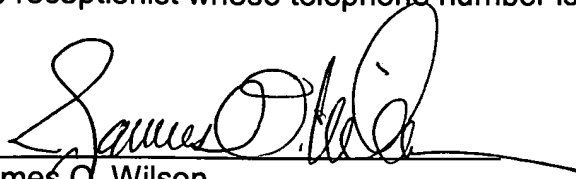
Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached on (571) 272-0661. The fax phone number for this Group is (571) 273-8300.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS  
January 5, 2007



James C. Wilson  
Supervisory Patent Examiner  
Art Unit 1624, Group 1600  
Technology Center 1